

REMARKS/ARGUMENTS

Claims 35-47 are pending. The Office Action rejects Claims 35-47 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Claims 35 and 46 are rejected under 35 U.S.C. § 112, second paragraph. Claims 35-41, 43, and 44-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2002/0010698 to Shin et al. ("Shin") in view of U.S. Pat. App. Pub. No. 2002/0082910 (incorrectly identified as 2002/0092910 in the Office Action) to Kontogouris ("Kontogouris"). Claim 42 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shin and Kontogouris in view of U.S. Pat. App. Pub. No. 2005/0123135 to Goddard ("Goddard"). Claim 47 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shin and Kontogouris in view of U.S. Pat. App. Pub. No. 2006/0183097 to Ishii ("Ishii").

In this response, Applicants have amended Claims 35 and 46. In light of the amendments and subsequent remarks, Applicants respectfully submit that the claims are in condition for allowance.

The Rejection of Claims 35-47 under § 112, First Paragraph is Overcome

The Examiner alleges that Claims 35-47 fail to comply with the written description requirement, positing that the recitation in Claims 35, 36, 39, 42, and 43 that "the selected content is presented upon each occurrence of a predefined condition associated with the selected content until the first selected locking requirement is met" is not supported in the specification. Applicants respectfully traverse the rejection and further respectfully submit that the Examiner has failed to even meet the initial burden imposed on the Examiner to present "by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." *See*, MPEP §§ 2163 (II)(A), 2163.04; *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

In this regard, "[i]n rejecting a claim, the examiner must set forth express findings of fact which support the lack of written description conclusion." The findings should "[e]stablish a *prima facie* case by providing reasons why a person skilled in the art at the

time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.” *See*, MPEP § 2163.04 (I).

At most, however, the Examiner has only alleged that the specification of the present application does not include a literal citation of the phrase “presented *upon each occurrence* [of] a predefined condition associated with the selected content until the first selected locking requirement is met.” In this regard, the Office Action merely states that the “specification describes a user selecting a particular content and the delivery server printing a locking option.... However, it does not support presenting a predefined condition upon each occurrence.” *See*, Sections 4 and 7 of the Office Action. However, the Office Action presents no finding of fact of “why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed” as required of the Examiner. Further, when Applicants amended Claims 35, 36, 39, 42, and 43 to recite “the selected content is presented upon each occurrence of a predefined condition associated with the selected content until the first selected locking requirement is met” in the response to the previous Office Action, Applicants cited to several portions of the specification which Applicants submit support the recitation and provided remarks on how the cited portions support the recitation. However, the Office Action fails to address any of the remarks.

Moreover, Applicants point out that the standard for meeting the written description requirement is not one requiring a literal recitation of claim phrases in the specification. *See, e.g.*, MPEP § 2163.02. “It should be noted...that exact terms need not be used *in haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112.” *See, e.g.*, MPEP § 1302.01; *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976).

Accordingly, given the standard for meeting the written description requirement set forth in the MPEP and the burden imposed upon the Examiner in establishing a rejection under § 112, first paragraph, Applicants continue to submit that support for the

recitation that “the selected content is presented upon each occurrence of a predefined condition associated with the selected content until the first selected locking requirement is met” is supported in several locations within the specification such that a person skilled in the art at the time the application was filed would have recognized that the Applicants were in possession of the invention as claimed in view of the disclosure of the application as filed.

In this regard, the “selected content” may be, for example, a ring tune or screen saver. *See, e.g.*, Page 10, lines 14-16 of the present application. The selected content may have a “predefined condition associated with the selected content” in that the selected content may be presented upon the occurrence of the predefined condition. For example, as is well known in the art, a ring tune may be played upon each receipt of an incoming call (*See, e.g.*, page 12, line 21 – Page 13, line 1 of the present application) and a screensaver may be displayed upon the elapse of a timeout period, such as a period of time during which a computing device is not actively used by a user. Further, page 13, lines 12-14 describe that a ring tune to be played may be locked content.

Page 8, lines 7-17 of the application provides a further example, wherein the selected content may be a movie’s theme song that may be locked in the user device as a tune until a locking requirement is met. Examples of locking requirements presented in this excerpt include a specified period of time, an amount of usage time for the user device, and a specified number of usages of the content. Thus, using the ring tune example, if the locking requirement is a specified amount of time, the ring tune may be played, i.e., presented, each time an incoming call is received during the period of time. If the locking requirement is an amount of usage time, the ring tune may be played each time an incoming call is received until the amount of usage time has been satisfied. If the locking requirement is a specified number of usages of the content, the ring tune may be played each time an incoming call is received until a number of incoming calls corresponding to the specified number of usages have been received.

For at least the foregoing reasons, Applicants respectfully submit that the rejection of Claims 35-47 under 35 U.S.C. § 112, first paragraph is overcome. However, if the Examiner maintains the rejection, Applicants request that the Examiner meet his

burden in establishing a rejection under the written description requirement by making specific findings of fact of “why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed” and particularly address each of the portions of the specification cited herein by the Applicants as supporting the claim recitation at issue.

The Rejection of Claims 35 and 46 under § 112, Second Paragraph is Overcome

Applicants have amended Claim 35 to recite “unlocking the selected content when the first selected locking requirement is determined to have been met such that the selected content is no longer required to be presented upon an occurrence of the predefined condition.” This amendment removes the phrase “repeatedly presented” and brings the claim language in parallel with the previously recited “such that the selected content is presented upon each occurrence of a predefined condition.” Applicants submit that this amendment is supported for at least those reasons argued above in connection with the § 112, First Paragraph rejection. Accordingly, Applicants respectfully submit that the rejection of Claim 35 under § 112, Second Paragraph is overcome.

The Office Action submits that Claim 46 is indefinite because “it is unclear what ‘manner’ is being used. Applicants believe the Examiner may have misinterpreted the claim recitation and have accordingly made an amendment to clarify the claim language. In this regard, Applicants have amended Claim 46 to recite “the at least the first selected locking requirement defines a manner by which to display the advertising content in human perceptible form.” Accordingly, the claim language recites that the locking requirement defines (e.g., sets forth) the manner in which (e.g., how) the advertising content is displayed. Thus it is irrelevant for claim purposes “what ‘manner’ is being used” as the claim recites that the manner in question is defined by the first selected locking requirement. Accordingly, depending on the particular locking requirement, any number of manners may be defined. Applicants therefore respectfully submit that the rejection of Claim 46 under § 112, Second Paragraph is overcome.

Examiner's Failure to Address Applicants' Traversals and Arguments Submitted in Previous Response

Prior to addressing the § 103 rejections, Applicants note that the Office Action fails to respond to each of the Applicants' arguments submitted in the previous response. In the present Office Action, the Examiner maintains the same references and same combinations thereof as were cited in the preceding Office Action, yet in the response to arguments section addresses only one of the Applicants' previously submitted arguments. Applicants note that the Examiner is required to answer all material traversed:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given. (*Manual of Patent Examining Procedure* § 707.07(f))

Applicants accordingly respectfully request that if the Examiner is to continue to assert the same references and combinations thereof that in the future, the Examiner address each of the Applicants asserted arguments.

The Rejection of Independent Claims 35, 36, 39, 42 and 43 under §103(a) is Overcome

The Office Action finds that independent Claims 35, 36, 39, and 43 are unpatentable over Shin in view of Kontogouris. The Office Action finds that Claim 42 is unpatentable over Shin in view of Kontogouris and further in view of Goddard. Briefly, the Shin publication describes a method of securing electronic documents and/or text messages that are transmitted through a network. See Shin at ¶¶ 0008-0009. These electronic documents are secured by a locking function that locks the message (i.e.,

prevents the message from being presented) until some predefined locking condition is satisfied. *See, e.g.*, Shin at FIG. 3C. Exemplary locking conditions include a date on which the electronic document can be opened, a particular reader who can open the electronic document, or questions that a potential reader must answer correctly in order to access the locked electronic document. *See* Shin at ¶ 0023. These locking conditions are chosen by the drafter of the electronic document and prevent the reader from accessing the document unless the locking conditions are satisfied. *See* Shin at ¶ 0024.

Accordingly, Shin teaches away from the claimed invention, in that independent Claims 35, 36, 39, 42, and 43 recite the selected content is presented upon each occurrence of a predefined condition associated with the selected content until the first locking requirement is met. Indeed, The Office Action states that “Shin does not expressly disclose the selected content is presented upon each occurrence of a predefined condition associated with the selected content until the first selected locking requirement is met.” The Office Action instead relies on Kontogouris as teaching the selected content is presented upon each occurrence of a predefined condition associated with the selected content until the first locking requirement is met.

Briefly, Kontogouris is directed to an advertising system and method which provides advertisers with an accurate way of measuring response, and banner advertisement therefore. In this regard, Kontogouris teaches an advertising system and method in which one or more banner advertisements are displayed when a user requests an electronic service or content and arranged to ensure a positive response by preventing access to an electronic address, service or content unless the user correctly responds to the advertisement. *See, e.g.*, Abstract of Kontogouris.

The Office Action posits that one of ordinary skill in the art would have been motivated to combine Shin and Kontogouris “because it prevents unauthorized access the locked content and conveniently provides incentives in a format suitable for mobile devices.” Applicants again note that the stated motivation is the opposite of the claimed invention. In this regard, the amended independent claims recite the selected content is presented upon each occurrence of a predefined condition associated with the selected content until the first locking requirement is met. Thus, as submitted previously in an

argument the Examiner did not respond to, the locked content in the claims is presented, unlike the combination cited in the Office Action. Further, Kontogouris, like Shin teaches preventing access to the selected locked content, i.e. the requested content, electronic address, or service. See, e.g., Abstract of Kontogouris. Accordingly, both of the cited references teach preventing access to the locked content, whereas the claims recite the selected content is presented upon each occurrence of a predefined condition associated with the selected content until the first locking requirement is met. Applicants therefore respectfully submit that neither Shin nor Kontogouris, taken alone or in combination, teaches or suggests the selected content is presented upon each occurrence of a predefined condition associated with the selected content until the first locking requirement is met. Goddard also does not teach or suggest that the selected content is presented upon each occurrence of a predefined condition associated with the selected content until the first locking requirement is met and is not cited for such.

In this regard, the Examiner's argument in the Response to Arguments section of the Office Action that "Kontogouris teaches at least one occurrence of presenting the selected content following a request for content until the locking condition is met...[and] [t]hus it is obvious to perform this feature for multiple occurrences" is moot. As posited above, the "selected/locked content" of Kontogouris is the requested content (i.e. service or content) for which access is prohibited until a user interacts with a banner advertisement in a specified manner, which may be regarded as a locking requirement. In contrast, the "selected/locked content" of the claims is presented until the locking requirement is met. Accordingly, Kontogouris does not teach or suggest even one occurrence of presenting the selected content until the locking condition is met.

Moreover, even if one were to regard Kontogouris as teaching the broad propositions which the Office Action asserts are taught by Kontogouris, one having skill in the art would not be motivated to combine Shin and Kontogouris to arrive at the claimed invention. Shin teaches away from any such combination, as Shin teaches preventing access to content (i.e., to electronic documents or text messages) for security purposes. Accordingly, one having skill in the art would not be motivated to combine a reference teaching presentation of selected content upon an occurrence of a predefined

condition until a locking requirement is met with Shin. Indeed, such a combination would not arrive at the invention claimed in independent Claims 35, 36, 39, 42, and 43, and would further defeat the teachings and purposes of Shin as presentation of the document prior to the locking requirement being met would compromise the security of the information protected by the locking condition taught by Shin. Even the Office Action admits as much, positing on Page 5 that one having ordinary skill in the art would have been motivated to combine Shin and Kontogouris "because it prevents unauthorized access [to] the locked content...." As already stated above, this reasoned combination asserted in the Office Action is opposite the invention recited in the independent claims, wherein the selected content is presented upon each occurrence of a predefined condition...until the...locking requirement is met. Therefore, even if the Examiner continues to hold that the teachings of Kontogouris are as broad as those alleged in the Office Action, there would be no motivation to combine Kontogouris with Shin and any such combination would not arrive at the invention claimed in independent Claims 35, 36, 39, 42, and 43.

Moreover, neither Goddard nor any of the other cited references teach or suggest that the selected content is presented upon each occurrence of a predefined combination associated with the selected content until the first selected locking requirement is met. Accordingly, none of the cited references, taken alone or in combination, teach or suggest independent Claims 35, 36, 39, 42, and 43 and as such independent Claims 35, 36, 39, 42, and 43 are patentably distinguishable from the cited references, taken alone or in combination, such that the rejection is overcome.

The Rejection of the Dependent Claims under §103(a) is Overcome

Because each of the dependent claims includes each of the recitations of a respective independent base claim, Applicants further submit that the dependent claims are patentably distinguishable from the cited references, taken alone or in combination, for at least those reasons discussed above and are in condition for allowance.

CONCLUSION

In view of the amended claims and remarks presented above, it is respectfully submitted that all of the present claims of the present application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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